

ADDITIONAL FEES:

No additional fees are believed required; however, should it be determined that a fee is due, authorization is hereby to charge any such fee to our Deposit Account No.

01-0268.

REMARKS

In the last Office Action, the inventor is incorrectly identified as Bruce L. Adams. Applicants request that the file be corrected to note that Bruce L. Adams is the attorney of record and not the inventor. The inventors are Shanman et al.

The Examiner repeated the rejection of claims 1, 2, 4-8, 12-13, 17-21 and 25-26 under 35 U.S.C. §103(a) as being unpatentable over Zip Coupons in view of Storey and Excite. Claims 1, 2, 4-8, 12-13 and 25-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zip Coupons in view of Excite and Scroggie et al. Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Zip Coupons in view of Excite, Scroggie et al. and Katz et al. Claims 11, 29-30 and 32-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zip Coupons in view of Excite, Scroggie et al. and Burke. Claims 25-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zip Coupons in view of Scroggie et al. and Burke.

In support of the foregoing rejections, the Examiner stated that Zip Coupons discloses the claimed structure including the plurality of consumer units, communication means, a server having a memory for storing retail outlet data and coupon data, a data processing unit, first means for transmitting a list of individually-selectable participating retail outlets through the selection of the types of coupons that the consumer is interested in, and display of available coupons, the associated merchants being identified with the coupons, second means responsive to the selection of a retail outlet for transmitting a list of individually-selectable goods offered for sale by the selected retail outlet, as illustrated through the representation and selection of the coupons, and third means for transmitting coupons corresponding to selected goods. The Examiner stated that through the selection of coupons for desired products or services, the consumer inherently selects products or services for purchase.

The Examiner pointed out that Zip Coupons discloses that advertisers will pay for placement of "zip" coupons on the Internet and consumers will select a coupon interest category, which implies that a list of the participating retail outlets are displayed. The Examiner further stated that while Zip Coupons does not explicitly show that the

participating retail outlets are individually selectable by the user and, in response to the selection of a retail outlet, a list of goods is transmitted, this is inherently disclosed by Zip Coupons, since the consumer selects coupons for products that he or she intends to purchase. On this basis, the Examiner concluded that it would have been obvious to modify Zip Coupons to specifically disclose that the retail outlets are individually selectable by the consumer and, in response to the selection of a retail outlet, a list of goods is transmitted for which discounts are available. The Examiner pointed out that when coupons are selected for each of the participating retail outlets as disclosed by Zip Coupons, products and retail stores are being individually selected by the consumer.

The Examiner further stated that Excite discloses that consumers are able to access coupons from online merchants personalized based on an individual's shopping interests, as may be portrayed by a shopping list. In view of this disclosure, the Examiner has taken the position that it would have been obvious to modify Zip Coupons to disclose a list of individually-selectable retail outlets and transmit a list of goods for which discount coupons are available.

The Examiner pointed out that Scroggie et al. disclose a method of obtaining a shopping list, whereby a list

of participating retail outlets is displayed to consumers for selection, transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer.

The Examiner cited Katz et al. as disclosing that the communications medium comprises a public telephone network and means for acquiring caller ID data to identify the geographical location of the consumer units, and that Burke discloses data representative of the physical layout of a retail outlet, including aisle location of goods offered for sale.

Burke was cited in support of the rejection of claims 25-29 as disclosing data representative of the physical layout of a retail outlet, including aisle location of goods offered for sale.

By the present amendment, claims 1-8, 11-13 and 25-28 have been canceled without prejudice or admission, thereby leaving only claims 29-40 pending. The subject matter of independent claims 29 and 40 has not been fully treated by the Examiner and is believed to be patentably distinct from the prior art of record for the reasons stated hereinbelow.

The present invention relates to a data processing system and method for the interactive generation of a

personalized shopping list over a network, the shopping list being customized to reflect a consumer's choice of a specific retail outlet by specifying aisle locations of goods selected for purchase by the consumer. The present invention also generates coupons based on the consumers selection of goods.

In accordance with independent claims 29 and 40, a consumer is shown one of a generic list of goods generally sold in a selected type of retail outlet or a specific list of goods sold in an actual retail outlet selected by the consumer. Once the consumer has indicated the items he or she plans to purchase from the displayed generic or specific list, the system returns to the consumer a shopping list that is customized to indicate the aisle locations of each intended purchase, within the selected retail outlet. The shopping list obtained becomes a roadmap of the selected retail outlet so the shopper can shop more efficiently.

The personalized shopping list permits manufacturers of products sold within the retail outlet selected by the consumer to electronically generate and deliver coupons categorically matched to planned purchases by a consumer prior to a consumer's actual visit to the retail outlet.

Moreover, as recited by independent claim 29, if coupons corresponding to the goods selected by the consumer are not available at the selected retail outlet, the claimed

system transmits coupons for competitively-branded goods or for the selected goods at another retail outlet, in addition to transmitting a personalized shopping list. This subject matter of independent claim 29 was not addressed by the Examiner in the lengthy statement of rejection.

Claim 40 recites a system which has a server that contains data identifying an inventory of goods offered for sale and graphical data for displaying a representation of the retail outlets including a physical layout of the goods in the retail outlets. The server further contains means for transmitting to a consumer unit for display thereon a representation of a selected actual retail outlet including the physical layout of the goods in the selected retail outlet. The Examiner relied upon Burke as disclosing the claimed limitations, but failed to acknowledge the significant distinction between displaying a simulated retail outlet, as disclosed by Burke, and the representation of an actual retail outlet selected by the consumer from a virtually unlimited number of actual retail outlets, as required by the instant claims.

Applicants respectfully submit that the prior art does not disclose or suggest the personalized shopping list containing the goods selected by the consumer in a selected retail outlet along with the aisle locations of the selected

goods in the selected retail outlet. While a shopping list is disclosed by Scroggie et al., the disclosed shopping list merely provides the consumer with a list of food items needed to prepare a selected recipe along with available coupons. The personalized shopping list of the present invention contains aisle locations at any one of an unlimited number of retail outlets.

Shoppers typically prepare a shopping list prior to visiting their preferred supermarket or other large retail outlet. This is done for convenience purposes and expedites the shopping experience. By offering consumers the ability to electronically prepare an interactive shopping list over a network through keyboard entries, mouse clicks, voice commands or via virtual shopping, consumers are given the added benefit of a customized shopping list and coupons tailored to their selection of goods. This enables consumers to obtain advanced knowledge of the aisle location of each intended purchase within their selected retail outlet and enhances shopping convenience. In addition to benefiting the consumer, the inventive system and method assists retailers in inventory anticipation and helps build customer loyalty. For manufacturers of products sold in the retail environment, the inventive system and method provides a targeted method of delivering coupons to pre-qualified customers that are

categorically matched to planned purchases, thereby avoiding the waste and inefficiency of conventional coupon distribution methods.

In rejecting the claims on the basis of Zip Coupons, Storey, Excite, Scroggie et al. and Katz et al., the Examiner relied solely upon the shopping list of Scroggie et al., which differs from the claimed shopping list. None of the cited references disclose the personalized shopping list of the present invention which, as described above, renders the present invention markedly distinct from the prior art.

More specifically, independent claims 29 and 40 recite a system in which consumer units are provided for receiving information over a network from a server which stores and transmits files containing a list of an unlimited number of actual participating stores, including name and location, inventory of each of the participating stores and (optionally) coupon data. The claims further set forth a particular system for the distribution of a personalized shopping list showing aisle location in an actual, selected store and optionally generating coupons associated with selected goods. The claims recite the generation of a personalized shopping list along with a series of other clearly defined steps that are absent from the cited references.

More specifically, independent claims 29 and 40 require the establishment of a link between a consumer unit (which may be a computer, a television, a telephone, a handheld computer, or the like) and a server computer over a communications medium; transmitting from the server to the consumer unit a list of participating retailers; displaying the list of retailers on the consumer unit so that the consumer may select one of the displayed retailers; transmitting from the server to the consumer unit a list of the inventory of goods of the selected retailer or a list of goods generally sold by a particular type of retailer selected by the consumer; and in response to the selection of one or more items of goods by the consumer, transmitting from the server to the consumer computer a file containing a list of the selected goods identifying the aisle location of the selected goods in a selected retail outlet and transmitting coupons for the selected goods.

Independent claims 29 and 40 recite subject matter that is not disclosed or rendered obvious by the cited prior art.

Zip Coupons, either alone or in combination with the one or more of Storey, Scroggie et al. Excite, and Katz et al., does not disclose a system for performing all of the following steps: (1) displaying a list of participating,

individually-selectable retail outlets; (2) displaying a list of either the inventory of goods offered for sale by a selected retail outlet or goods generally sold by a particular type of retail outlet selected by the consumer; (3) allowing the consumer to select one or more of the displayed goods; (4) providing a shopping list identifying the physical location (aisle number) of the selected goods in the selected retail outlet; and (5) generating coupons for the selected goods after the foregoing selections are made.

Step (4) above is neither disclosed nor suggested by the cited references.

Zip Coupons merely discloses the concept of targeted coupon distribution by disclosing that coupons for certain generic product categories (not retail outlets) can be accessed by a consumer based on zip code. Zip Coupons does not disclose any structure or method for the generation of a customized shopping list based on selections of goods by a consumer from a list of user-selectable goods available at a selected retail outlet.

Accordingly, Zip Coupons does not disclose or suggest the structure or steps of claims 29 and 40, each of which requires that the server transmit to a consumer unit, in response to the selection by the consumer of one of the displayed retailers, a list of the inventory of goods of a

selected retailer and displaying the list on the consumer unit.

Neither Scroggie et al., Storey nor Excite cure the foregoing defects of Zip Coupons. The references do not disclose a system responsive to selections made from a list of participating user-selectable retail outlets and user-selectable goods to generate a customized shopping list containing a list of the selected goods and aisle locations of the selected goods at the selected retail outlet.

Claims 29 and 40 recite a system and method in which a coupon server transmits and displays on a consumer unit a file containing a list of participating retail outlets for selection of a retail outlet by a consumer and another file containing the inventory of goods sold at the selected retail outlet (or a generic list of goods generally sold at a particular type of retail outlet). The server is responsive to consumer selections to distribute a list of selected goods identifying the aisle location of the selected goods in the selected retail outlet and optionally for distributing coupons based on the selected goods. Neither Zip Coupons, Scroggie et al., Storey or Excite disclose or suggest the claimed combination of structure or method steps.

Burke was cited as disclosing data representative of the physical layout of the participating retail outlets

indicating the location of the goods offered for sale, and means responsive to the selection of one or more items of goods by the consumer to transmit a file for display on the display monitor of the consumer unit containing data identifying the location in the selected retail outlet of the goods selected by the consumer.

Applicants respectfully note, however, that independent claims 29 and 40 recite that the file transmitted from the coupon server to the respective consumer unit in response to the selection of one or more items of goods by the consumer contains data identifying the aisle location in the selected retail outlet of the goods selected by the consumer.

Stated otherwise, the claims do not merely recite a virtual online shopping system of the type disclosed by Burke, but disclose the online generation of a customized shopping list for use at an actual retail outlet. Burke does not contemplate an actual retail outlet and discloses a hypothetical store having a hypothetical layout. The Burke "warehouse" does not exist in the physical world, so that no legitimate argument can be made that Burke somehow suggests the generation of a customized shopping list containing aisle numbers for use by a consumer while shopping at an actual store. Burke conveys a graphical representation of a non-

existent store with shelves stocking as many as all of the 50,000 types of goods offered for sale throughout the entire country as maintained by national databases. The server of the Burke virtual store contains data identifying the virtual location of goods solely to graphically render the visual images of the hypothetical warehouse. However, the physical location data is not provided to the consumer in the form of an actual store layout and no shopping list of selected goods containing aisle numbers of the goods in the actual, selected retail outlet is provided by Burke, as required by independent claims 29 and 40.

Claims 29 and 40 recite a system for generating a shopping list containing selected goods available at an actual retail outlet selected by the consumer. The list containing the participating retail outlets may contain an unlimited number of actual participating retail outlets, thus enabling the inventive system and method to enable consumers over a large geographic area to obtain shopping lists customized to retail outlets in their local area, as recited by various dependent claims. The customized shopping list is transmitted to the user by the coupon server in a format which identifies the consumer's selected goods along with the aisle location in the selected actual store at which the selected goods are sold, and optionally transmits coupons for the selected goods.

Burke, on the other hand, discloses the generation of a simulated warehouse on a consumer computer, which enables consumers to purchase goods online. Although the server of Burke contains data specifying the physical layout of the warehouse, this data is used solely for rendering the graphics required to implement a virtual online store. Burke does not disclose the transmission of a shopping list containing aisle locations of selected goods at an actual retail outlet.

According to the claimed invention, consumers do not shop at a virtual supermarket, but select goods online and receive a list of the selected goods along with a shopping list identifying the aisle location in the actual retail outlet at which the goods are located. The consumer physically visits the selected store after obtaining the list identifying the aisle location and optional coupons for the selected goods. This is markedly distinct from the Burke reference.

Accordingly, applicants respectfully submit that the subject matter of claims 29-40 is markedly distinct from that disclosed in Zip Coupons, Storey, Excite, Scroggie et al., Katz et al. and Burke, and that the rejection based on these references should be withdrawn.

In view of the foregoing amendments and discussion, the application is now believed to be in condition for

allowance. Accordingly, entry of the present amendment together with favorable reconsideration and allowance of the claims are most respectfully requested.

Respectfully submitted,

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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner of Patents & Trademarks, Washington, D.C. 20231, on the date indicated below.


Bruce L. Adams

Attorney Name

Signature

NOVEMBER 1, 2002

Date